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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/585,191	09/14/2007	Nina Miikki	0696-0243PUS1	9230
2292 7590 09/30/2010 BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747				
EXAMINER FORTUNA, JOSE A				
ART UNIT		PAPER NUMBER		
1791				
NOTIFICATION DATE		DELIVERY MODE		
09/30/2010		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

Office Action Summary

Application No.

10/585,191

Applicant(s)

MIIKKI ET AL.

Examiner

José A. Fortuna

Art Unit

1791

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 September 2010.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
4a) Of the above claim(s) 1-17 is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-10 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 15 August 2008 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB-08)
Paper No(s)/Mail Date _____
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of group I, claims 1-10 in the reply filed on September 14, 2010 is acknowledged. The traversal is on the ground(s) that that'll not be a serious burden in the examination if the groups were examined together. This is not found persuasive because Applicant's arguments do not point out the supposed errors in the restriction requirement by showing or evidence as required by the MPE §803 *infra*..

As to the Burden of search, the MPEP 803 states:

"For purposes of the initial requirement, a serious burden on the examiner may be prima facie shown if the examiner shows by appropriate explanation of separate classification, or separate status in the art, or a different field of search as defined in MPEP § 808.02. That prima facie showing may be rebutted by appropriate showings or evidence by the applicant. Insofar as the criteria for restriction practice relating to Markush-type claims is concerned, the criteria is set forth in MPEP § 803.02. Insofar as the criteria for restriction or election practice relating to claims to genus-species, see MPEP §806.04(a) - §806.04(i) and § 808.01(a)."

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 11-17 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on September 14, 2010.

Claim Objections

3. Claim 3 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the

claim(s) in independent form. Claim 3 recites that the marks of claim 1 are made by rolls; yet claim 1 recites that the marks are made by laser beams.

Specification

4. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed in view of the invention election/restriction.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 3 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 3 is vague and indefinite since it is unclear how this is done in view of the limitations of claim 1, i.e., claim 1 explicitly teaches that the marks are made with laser beams, yet claim 3 recites that the marks are made by engraving rolls which seems to contradict the independent claim. It is unclear if the marking are made by engraving containing a laser beam or there are other marks that are made by the engraving rolls, i.e., different than the ones recited in claim 1, further comprising?

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-7 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 2003-013395

A, referred hereafter as JP'395, (Machine translation and the translation of the reasons for rejection included in the IDS filed on July 27, 2010.

JP'395 teaches a process of making a marked multilayer/multiply webs in which a moving fibrous web **10** is marked and then papermaking fibrous slurry is deposited onto the marked web, see figure 1b and abstract. JP'395 teaches that the markings/holes can be done by laser, see ¶-[0046] of the reference, (¶-[0019] of the detailed description on the machine translation). Note that the holes in the fibrous web **10** is done by laser the surface would be inherently burned. JP'395 teaches the use of other types of fibers, such as bleached and unbleached pulps for the making of the web; see claim 12 and ¶-[0012]. JP'395 teaches also that the web **10** can be watermarked with a dandy or a press roll, see ¶-[0021] and which reads on the marking with engraving rolls as claimed. JP'395 teaches the use of additives into the web to help in the making of the hole, with a laser, see ¶-[0016]-[0019] of the detailed description section.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

11. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

12. Claims 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP'395, cited and discussed above.

JP'395 does not explicitly teach the use of the different type of pulps as claimed nor the coating of the web **10**. However, the use of such pulps is well known in the art and using within the pulps suggested by the JP'395, i.e., using different pulps in headboxes 9a and/or 9b and as the making of web **10** would have been obvious to one of ordinary skill in the art, since he/she would have reasonable expectation of success if such common pulps were used in the JP'395's environment. As to claim **10** the coating of the web **10** would also be obvious to one of ordinary skill in the art for different reasons: 1) adhesive

bonding of the web with layers 12a and/or 12b: 2) to cover the holes so that there is no fibrous penetration through such holes.

13. Claims 1-10 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Brownfield, US Patent No. 6,306,493.

Brownfield teaches a laser marked/burned web, which is made using papermaking pulps in which micronized polymers are added to the pulp, (the additives claimed in 4 of the present application), see abstract. Brownfield teaches that the laser marks are done at high speed, column 1, lines 18-22 by placing it, the web, in a path with the laser beam, column 2, lines 47-59. Brownfield teaches also that the web is made with the same type of pulps as claimed and that can be coated to cover the marks in the web, column 2, line 61 through column 3, line 52. Brownfield teaches the different use of the web and teaches that the web can be laminated with other type of papers/web, see column 5, lines 1-30. It seems that Brownfield teaches all the limitations of the claims or at least the minor modification(s) to obtain the claimed invention would have been obvious to one of ordinary skill in the art.

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure in the art of "Laser Marked, Multilayered Papers."

DE 3431577 and WO 99/60208 teach the marking of moving webs by the use of lasers.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to José A. Fortuna whose telephone number is 571-272-1188. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew J. Daniels can be reached on 571-272-2450. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/José A Fortuna/
Primary Examiner
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JAF